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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/608,160 | 06/30/2003 | Yoshiko Naitoh | 03560.003328. | 8128 |
| 5514 7590 07/09/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | EXAMINER HUSSAIN, TAUQIR | |
| | | | ART UNIT 2152 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/608,160 | Applicant(s) NAITOH, YOSHIKO | |
| | Examiner Tauqir Hussain | Art Unit 2152 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,9-11,13,15,19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,9-11,13,15 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to amendment filed on May 03, 2007. Claims 2,4,6-8,12,14 and 16-18 are cancelled. Claims 1,3,5,9-11,13,15 and 19-22 are pending in this application. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.
2. Priority date is considered for foreign priority of Japanese patent dated 07/12/2002. Prior art used in office action dated 02/05/2007 by Schlonski et al has the provisional filing date of 03/28/2002; hence beat the applicant's above claimed priority date.
3. As per amendment to claim 1 and 22, the U.S.C 101 rejection has been withdrawn.
4. Claims rejection under U.S.C 112 second paragraph has been withdrawn as claims have been amended as per requirement of U.S.C 112 second paragraph.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1,3,5,9-11,13,15,19-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlonski et al. (Pub. No.: US 2003/0093521 A1), hereinafter "Schlonski" in view of Yada (Pub. No.: Us 2001/0029474 A1), hereinafter "Yada".

7. As to claims 1,11, 21 and 22 e.g. apparatus, method, program and storage medium, an information processing apparatus that manages a predetermined device capable of performing communication over a network (Schlonski, Abstract), comprising:

a holding unit configured to hold corresponding information corresponding to first device identification information and second device identification information (Schlonski, Abstract, where database is holding unit which keeps the corresponding information to all the devices on the network);

an obtaining unit configured to obtain accounting information base on an image forming operation from the predetermined device (Schlonski, Fig.1, element 100 can be interpret as obtaining unit, [0018, lines 8-13], where print count can be interpret as accounting information based on image forming operation);

a comparing unit configured to compare a combination of the first device identification information and the second device identification information which are obtained from the predetermined device with the corresponding information held by the holding unit (Schlonski, Fig.1, element 100 could be comparing unit, [0016, lines 12-18]; where IP address and Mac address are used as asset identification and [0022, lines 1-7]; where based on that ID is compared with the ID's in the database/holding unit which keeps the corresponding information), and determine whether or not at least one of the first device identification information and the second device identification information is being managed;

the external apparatus being capable of receiving the notification through a predetermined communication line and managing a plurality of information processing apparatus (Schlonski, [0040], where mutually independent or other entities can communicate together); and

an updating unit configured to update the corresponding information held by the holding unit in accordance with an update notification ([0039, lines 1-7], where asset information is updated in the database manager and where notification is SNMP status messages), for updating the combination of the first device identification information and the second device identification information (Schlonski, [0039, lines 6-11], where new device 10 is added to the database where other devices are already recorded with the combination of IP and MAC addresses), from the external apparatus (Schlonski, [0040, lines 1-4, where other entities means external apparatus can also be managed by single asset manager running on one server),

wherein the notification issued by the communication controlling unit includes information indicating that either the first device identification information or the second device identification information is not being managed (Schlonski, [0038], where status polling is perform with predetermined regularity for maintenance purpose which includes malfunctioning or devices, which means if a device is malfunctioning than it can not be managed until it is fixed and that device could be first or second device), and

wherein the communication controlling unit restricts issuing the accounting information obtained by the obtaining unit to the external apparatus (Schlonski, Fig.9, [0039, lines 11-15], where import and export of a report is an option in asset

management, which means reports does not transmit automatically to asset management) if the comparing unit determines either the first device identification information or the second device identification information is not being managed (Schlonski, [0038], where status polling is perform with predetermined regularity for maintenance purpose which includes malfunctioning or devices, which means if a device is malfunctioning than it can not be managed until it is fixed and that device could be first or second device), and removes the restriction and issues the accounting information obtained by the obtaining unit to the external apparatus if the corresponding information is updated by the updating unit (Schlonski, Fig.9, [0038], where as explained earlier once the device is fixed and online obviously there is a update mechanism that updates the database about the device as soon it becomes online or manageable).

Schlonski does not disclose, a communication controlling unit configured to control issuance of a notification to an external apparatus in accordance with a result of the comparison by the comparing unit. However, Yada discloses, a communication controlling unit (yada, [0009, lines 20-21] configured to control issuance of a notification to an external apparatus in accordance with a result of the comparison by the comparing unit (Yada, [0009, lines 1-20, where asset management process includes the status information and comparison process before registering the device along with all other network associated information).

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Schlonski and Yada in order to

provide an asset management system in which asset management information including the location of an asset is gathered from information on a sender and a destination included in the header of information circulating over a computer network, a software program created by use of an API capable of conversing with the OS of an asset.

8. As to claims 3 and 13, Schlonski and Yada disclose the invention substantially as in parent claims 1 and 11, including, further comprising a receiving unit configured to receive the corresponding information from the external apparatus through the communications line (Schlonski, [0040], where asset manager is managing mutually independent or other entities meaning there has to be a communication lines setup already).

9. As to claims 5 and 15, Schlonski and Yada disclose the invention substantially as in parent claims 1 and 11, including, an inputting unit configured to input an instruction for updating the first device identification information and /or the second device identification information (Schlonski, [0025, lines 7-12], where manual entries added in the printer information properties), wherein the communication controlling unit issues a notification for update (Schlonski, [0039, lines 6-8], where discovering new network device means there has been issues a notification, based on the update instruction input by the inputting unit, to the external apparatus (Schlonski, [0025, lines 7-12], where manual entries added in the

printer information properties and as explained in [0040] these devices could be from other entities or mutually independent companies).

10. As to claims 9 and 19, Schlonski and Yada disclose the invention substantially as in parent claims 1 and 11, including, wherein the first device identification is an internet protocol address (Schlonski, [0016, lines 12-13], where IP address in the device identification).

11. As to claims 10 and 20, Schlonski and Yada disclose the invention substantially as in parent claims 9 and 19, including, wherein the second device identification information includes at least MAC address information (Schlonski, [0016, lines 15-18], where device address is a MAC address which could be second device).

Examiner's Note: Examiner has cited particular columns and line numbers in the references, as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

Response to Arguments

12. Applicant's arguments filed on 05/03/2007 have been fully considered but they are not persuasive.

13. Applicant argues, Schlonski does not disclose, "an obtaining unit configured to obtain accounting information...", however Examiner respectfully disagrees because if we look at Fig.2A-2D or any other Figures it is clear that asset management is collecting very specific information on each attached network devices and further [0018] discusses specifically about print specific information and further it would be obvious to one ordinary skilled in the art to derive related information along these lines which is disclosed by Schlonski.

Applicant further argues, "a communication controlling unit configured to control issuance of notification....". Examiner respectfully disagrees, as depicted in Fig.9, the import export is done via "Wizard" therefore, obviously there is a communication controlling mechanism in place which will also be capable of handling notification to external apparatus as explained in [00040].

Applicant argues, Yada does not remove any deficiencies on Schlonski. However, Examiner disagrees as Yada discloses specifically about "communication controlling unit" in the Asset management environment see [0009], where controller is capable of gathering the management information of the asset belonging to the section of the asset management client which could be external client or device.

Therefore, the claims stand as previously rejected with the new amended claim rejections in this final office action.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

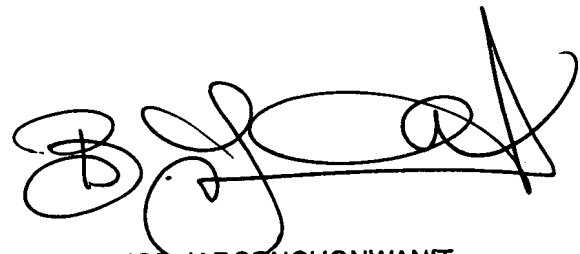
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tauqir Hussain whose telephone number is 571-270-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571 272 3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

7/3/7